

REMARKS

Claims 1-53 are pending in the case, claims 20-53 having been improperly withdrawn through restriction. The Office rejected claims 1-19 as follows:

- claims 1-4, 9-10, 14-15, and 17-18 as anticipated under 35 U.S.C. §102(e) by U.S. Letters Patent 6,010,139 (“Heyring et al.”);
- claim 5 as obvious under 35 U.S.C. §103(a) over Heyring et al. in combination with U.S. Publication No. 2003/0001734 (“Schofield”);¹
- claims 6 and 15 as obvious under 35 U.S.C. §103(a) over Heyring et al. in combination with U.S. Patent No. 6,267,196 (“Wilcox”);
- claims 7-9, 13, 16 and 19 as obvious under 35 U.S.C. §103(a) over Heyring et al. in combination with U.S. Patent No. 4,313,511 (“Soo Hoo”); and
- claims 11-12 as obvious under 35 U.S.C. §103(a) over Heyring et al. in combination with U.S. Patent No. 4,243,278 (“Horan”).

Applicants maintain their traversal of each of the rejections. As such, Applicants hereby incorporate their arguments in response to these rejections set forth in their “Response to Office Action Dated March, 31, 2008”, in full as if set forth *verbatim* herein. This is particularly true in light of the fact that the Office has yet to meaningfully address, much less rebut, those arguments.

I. THE RESTRICTION IS STILL IMPROPER

Applicants request reconsideration of the restriction requirement recently made final. In addition to violating the principle of compact prosecution, *see* M.P.E.P. §811, the Office’s own actions establish that the requirement is improper. In particular, the present requirement was first proposed in the Office Action dated October 24, 2007. Since that time, and before making the requirement final, the Office already examined all the withdrawn claims and those claims actually went on appeal. It is too late in the game for the Office to now claim that the withdrawn

¹ Applicants do not concede the status of Schofield as “prior art”. Schofield does not actually qualify as prior art under any provision of 35 U.S.C. §102. The Office may nevertheless cite Schofield under the legal fiction that it evidences what was “known by others” under 35 U.S.C. §102(a) on the assumption that Applicants’ data of invention is their date of filing. Applicants reserve the right to “swear behind” Schofield at a future date should they choose to do so. *See* M.P.E.P. §2132.91.

claims must be withdrawn as presenting an undue burden. Applicants accordingly request that the withdrawn claims be rejoined and that their improperly truncated examination resume.

II. SUBSTANTIVE MATTERS

A. THE OFFICE HAS FAILED TO ESTABLISH UNPATENTABILITY

All of the substantive rejections rely upon the propriety of the anticipation rejections of the independent claims 1 and 14. More particularly, there are two sets of rejections—one set for anticipation and one set for obviousness. In the first set, the Office rejected claims 1-4, 9-10, 14-15, and 17-18 as anticipated by Heyring et al. The second set comprises several different obviousness rejections of claims 5-8, 11-13, 16, and 19 on various combinations of Heyring et al. and other art. However, each of these claims depends from either claim 1 or claim 14, and relies upon Heyring et al. to teach all the limitations of those claims.

However, the Office never properly established *prima facie* anticipation of either claim 1 or claim 14 by Heyring et al. As the courts have explained:

The *prima facie* case is a procedural tool which, as used in patent examination (as by courts in general), means not only that the evidence of the prior art would reasonably allow the conclusion the examiner seeks, but also that the prior art compels such a conclusion if the applicant produces no evidence or argument to rebut it. Upon rebuttal, the decision is made on the entirety of the record.

In re Spada, 15 U.S.P.Q.2d (BNA) 1655, 1657 (Fed. Cir. 1990) (n. 3, citations omitted).

The Office has not provided a reasonably viable construction of Heyring et al. that teaches all the limitations of claims 1 and 14. It is true that the Office put forth a construction of Heyring et al., but Applicants showed that:

- (1) it was contrary to the disclosure of Heyring et al. at col. 5, lines 17-31;
- (2) relies on a misconstruction of Heyring et al. at col. 2 line 58 to col. 3, line 16; and
- (3) relies on an alleged admission that never was.

(“Response to Office Action Dated March, 31, 2008, pp. 12-15) Thus, it cannot be said to be a construction that “would reasonably allow the conclusion the examiner seeks” or one that “compels such a conclusion if the applicant produces no evidence or argument to rebut it”.

But even if it can be said that the Office's construction constitutes a *prima facie* anticipation, Applicants have clearly produced "evidence or argument to rebut it" as outlined immediately above. The Office's response to that argument falls well short of the mark:

The examiner respectfully maintains his position although applicants argue about distinguish features in the specification since applicants' broad claims read on existing cited references.

(Office Action dated December 2, 2008, "Detailed Action", p. 2, ¶3) And that is the Office's complete response to Applicants' arguments and evidence. Thus, it is apparent from this language that the Office did not even consider Applicants' argument and evidence and merely reasserted its original conclusion. This is clearly contrary to law, which requires "the decision is made on the entirety of the record." *Spada*, 15 U.S.P.Q.2d (BNA) at 1657.

III. CONCLUDING REMARKS

Applicants respectfully submit that all claims are in condition for allowance. This includes the independent linking claims, meaning the unelected groups must be rejoined and allowed.

The Examiner is invited to contact the undersigned attorney at (713) 934-4053 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

Date: February 2, 2009

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